

## REMARKS

This amendment is being filed as a response to the Office Action of September 20, 2007. Reconsideration is respectfully requested in view of these clarifying amendments and remarks. The only claim amendment has been made in Claim 8 to correct a clerical mistake, and no new subject matter has been added.

### Rejections under 35 USC § 103(a)

Claims 1-3, 8, 9-11, and 16-18 were rejected under 35 U.S.C. 103(a) as being unpatentable over Nykanen et al. (US Publication No. 2003/0133554), in view of Humphrey et al. (U.S. Publication No. 2004/0003039). Applicants respectfully request reconsideration of these rejections in light of the arguments contained herein.

Nykanen teaches that “[t]he present invention enables the interface module to maintain information on the business relationships between the associated networks and to employ a decision function with multiple parameters to automatically select the best match NSB [Network Service Broker] or web service component as requested by the application” (Paragraph [0011] - emphasis added). Humphrey teaches a game server that provides hosting services by connecting to a peer group, and enabling the server device to accept and respond directly to searches for the hosting services, which are directed at the peer group by one or more gaming client devices. Further, Humphrey teaches discovery of peer group gaming content as well as updating such content are also provided by the present invention, and further enabling both peer group protocol supported and non-supported devices to interact with and provide the services provided by a peer group (see Abstract).

The Examiner has asserted that it would have been obvious to one of ordinary skill in the art at the time of the invention to include the ability to update services in a system that allows for service provisioning, as taught by Humphrey in the system of Nykanen, with the

motivation that “service provisioning systems must necessarily use the latest services, which would therefore require an updating mechanism, such that the latest services are available.”

Applicants respectfully disagree and point out that the rationale to support a conclusion that the claim would have been obvious is that “a person of ordinary skill in the art would have been motivated to combine the prior art to achieve the claimed invention and that there would have been a reasonable expectation of success.” *In re DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1360, 80 USPQ2d 1641, 1645 (Fed. Cir. 2006), (See Fed. Register Vol. 72, No. 195, dated Oct. 10, 2007, page 57534).

Nykanen uses a central Application 202, used to select the best NSB's, while Humphrey uses a peer-to-peer network. A person of ordinary skill in the art would have not been motivated to combine two systems with radically different principles of operation, because a centralized system relies on the information and availability of a central server, while a peer-to-peer system relies on intra-client communications and it makes information available by using a large number of peers in the group. Therefore, the Applicants respectfully submit that Nykanen and Humphrey's systems are not obvious to combine. For instance, the combination of Nykanen and Humphrey *would be inoperable*, because adding updates based on peer-to-peer communications would not work in a system without peer-to-peer communications.

The Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit, *In re KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S. \_\_\_, 82 USPQ2d 1385 (2007). The Court in KSR quoted *In re Kahn*, which stated that “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” The Office has failed to explain why “service provisioning

systems must necessarily use the latest services,” and thus has not provided articulated reasoning to support the legal conclusion of obviousness.

In addition, the Office has dismissed Applicants claims under Official Notice, stating that the concept of updating services in response to new services is very well known in the area of service provisioning, with system updates for desktop PCs being an example. Applicants respectfully traverse. Note excerpt from MPEP below.

“If the applicant traverses such an [Official Notice] assertion the examiner should cite a reference in support of his or her position.” See MPEP 2144.03.

There are many ways of updating devices, such as automated network updates with or without user intervention, via CD's, from permanent memory, etc. Furthermore, updating an application in a mobile device can be very different from doing a system update on a PC. Therefore, the Office has failed to provide a specific showing of the subject matter in ALL of the claims. Applicants formally request a specific showing of the subject matter in all of the claims in any future action.

Claim 1 describes discovery transactions that allow an adapter software component to retrieve information regarding services available to a client device from a provisioning application, wherein one of said services comprises a plurality of content files capable of being installed on the client device. The Office alleged that Paragraphs [0010], [0011], [0013], and [0034] from Nykanen taught the aforementioned limitation. Applicants have reviewed these Paragraphs but cannot identify the language that corresponds to the technique “wherein ... a plurality of content files [are] capable of being installed on the client device” (emphasis added), as claimed. Specifically, in the paragraphs relied upon by the Office, Nykanen teaches “to automatically select the best match NSB or web service component as requested by the application” (Paragraph [0011]). However, providing information on the best match Network Service Broker or web service component does not imply providing the

actual content to the remote terminal. Providing the information on what remote server to use, typically a NSB in proximity to the user, and what services are available there, is not the same as providing the actual content files, as claimed.

Still yet, Paragraph [0034] from Nykanen teaches a list 204 so the application may track the service level that is available to the application. Items in the list 204 include Application ID, Service Provider Virtual ID, User Virtual ID, Cost Function, and Business Agreement, as seen in Fig. 2. These are items that help the application match users with NSBs, but there is no suggestion in Nykanen that items such as content files for the services are kept in list 204, as they are not needed to select the best NSB. Therefore, a list with information about Service Providers, and users, as in Nykanen, fails to meet a service that comprises a plurality of content files capable of being installed on the client device, as claimed.

In the Office Action dated June 12, 2007, the Examiner responded to Applicant's arguments by arguing that "[t]he limitation teaches that a software component retrieves information regarding available services to a client from a provisioning application, where the service constitutes content files to be installed on the client," and that "Nykanen fully teaches this limitation, where the available services from a provider to a client are discovered, which are constituted by installable objects."

Applicants respectfully disagree. There is no teaching in Nykanen that the services are constituted by installable objects, as claimed by the Office. As discussed hereinabove, Nykanen teaches how to select the best NSB or discover service availability, but there is no description in the excerpts relied upon by the Examiner of any installable objects, making this rejection moot.

Claim 1 describes delivery transactions that allow the adapter to facilitate downloading of data related to services to the client device, with the delivery transactions including an update transaction that allows the adapter to obtain a provisioning update comprising a list of said services that should be installed on the client device and a notification transaction that allows the provisioning application to request said adapter to perform said update transaction. The Office has relied on Paragraphs [0007], [0024], [0038], [0055], [0060], [0064], and [0068] from Humphrey to meet Applicants' limitation. However, Humphrey is a peer-to-peer system, as discussed hereinabove, and the adapter is not the one that downloads the data related to said services. For example, in Fig. 6, steps 610 and 620 show that the content index is received from peer nodes, and not from an adapter, as claimed. Again, using a peer system to share content, and more specifically to get information on available updates, as in Humphrey, does not teach having the adapter downloading data related to said services, as claimed, and the Office's rejection is improper.

Independent Claims 9 and 17 are deemed allowable for at least the same reasons as with Claim 1. In view of the foregoing, the Office is requested to withdraw the rejection of the independent claims (Claims 1, 9, and 17) under §103. Thus, a notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

The dependent claims are submitted to be patentable for at least the same reasons the independent claims are believed to be patentable. The Applicants therefore respectfully request reconsideration and allowance of the pending claims. A Notice of Allowance is respectfully requested.

If the Examiner has any questions concerning the present amendment, the Examiner is kindly requested to contact the undersigned at (408) 774-6920. If any other fees are due in connection with filing this amendment, the Commissioner is also authorized to charge Deposit Account No. 50-0805 (Order No. SUNMP154). A duplicate copy of the transmittal is enclosed for this purpose.

Respectfully submitted,  
MARTINE PENILLA & GENCARELLA, LLP

/Jose M. Nunez/

Jose M. Nunez  
Reg. No. 59,979

710 Lakeway Drive, Suite 200  
Sunnyvale, CA 94085  
Telephone: (408) 749-6900  
Facsimile: (408) 749-6901